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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,986	03/24/2005	Robert Simm	3210	6382
7590 Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743			EXAMINER CADUGAN, ERICA E	
			ART UNIT 3722	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/29/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/528,986

Applicant(s)

SIMM ET AL.

Examiner

Erica E. Cadugan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 20070118.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is a second action, non-final, rejection in response to Applicant's response filed November 13, 2006.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on October 6, 2003. It is noted, however, that no certified copy of the German parent application has been received. It is also noted that the Office action mailed August 17, 2006 indicated that applicant was required to file such a certified copy of the application to be in accordance with 35 USC 119(b). However, Examiner notes that this statement was in error, as the present case is a national stage application filed under 35 USC 371, and thus the burden for filing the certified copy of the German priority document is not applicant's but instead is the responsibility of the World Intellectual Property Organization (WIPO), which, as of present, has not submitted such.

Examiner does note that if any intervening reference (with an effective date between the priority date of the German parent application and the filing date of the international application (between 10/6/03 and 9/3/04) is applied, it would then be Applicant's burden to submit a certified translation of the German priority document (as at this time, the only certified translation that has been filed is of the international PCT application).

The Office regrets any inconvenience or confusion caused by the previous office action's comment on the priority.

Specification

3. The abstract of the disclosure is objected to because it is not in the form of a single paragraph. Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities: the disclosure on page 1 refers to the claims by number. Applicant is required to amend the specification to remove these references and to incorporate into the disclosure the subject matter of these claims that is necessary to the understanding of the invention. No new matter may be entered.

Comment on Amendment

5. It is noted that, as indicated in the attached interview summary, in the preliminary amendment of the claims of March 24, 2005, claim 4 was amended so as to eliminate the multiple dependency and to only depend from claim 1. However, in the amendment filed November 13, 2006, claim 4 is again presented as having multiple dependency, and does so without any editing marks showing that the dependency from claim 1 has been deleted and that the multiple dependency shown in lines 1-2 of the claim has been added.

In the interview of January 18, 2007, Mr. Striker indicated that claim 4 should still depend from claim 1 only. Thus, for purposes of an analysis of claim 4 with respect to the prior art (and/or otherwise) in response to the amendment filed on November 13, 2006, Examiner is treating claim 4 as though it was not a multiple dependent claim, and as though it depended from claim 1 only.

However, it is noted that any future amendments should correct this issue.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 15-16 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 15 sets forth that “the suction head (14a-14c) has a suction part (34a-34c) which forms an indivisible unit (72a-72c) with the dust container (12a-12c)”. However, this limitation does not appear to be supported by the specification as originally filed.

It is noted that while no particular structure or means for enabling the division of the suction part from the dust container is disclosed, that does not necessarily mean that the two are “indivisible” as claimed. Note that at the very least, the two could be divided by sawing them apart.

Re claim 21, it is noted that claim 21 sets forth that the air and removed material that are suctioned up through openings 30a, 30a-30c in the suction part 34a-34c are introduced perpendicularly to a working direction 24a “directly” into the dust container 12a-12c. However, it does not appear that the specification as originally files supports that the introduction of the air and removed material “directly” (emphasis added) into the dust container 12a-12c.

With respect to the first embodiment of Figures 1-6, note that the air and removed material suctioned up through openings 30a, 30a', is introduced perpendicularly to the working direction 24a into the dust container 12a indirectly via duct section 82a.

With respect to the second embodiment of Figures 7-17, note that the dust and air suctioned up through the openings are introduced into the dust container indirectly via suction duct 60b (see Figure 13 and page 10, lines 1-3, for example).

With respect to the third embodiment of Figures 18-24, the specification as originally filed also does not specifically teach that the dust and air suctioned up through the openings are introduced into the dust container "directly".

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-4 and 6-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "a

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power tool”, and the claim also recites “in particular for a drilling and/or chipping tool” which is the narrower statement of the range/limitation.

There are several positively recited limitations that lack sufficient antecedent bases in the claims. A few examples of this are: “the dust container” in at least claim 1, line 4 (previously “at least one ...”; note that claim 1 is not the only such occurrence); “the suction head” in at least claim 1, line 4 (previously “at least one...”; note that claim 1 is not the only such occurrence); “the unit” in claim 6 (note that claim 4 sets forth both a “unit” and a “bearing unit” and thus it is unclear to which of these “the unit” in claim 6 refers); “the opening” in at least claims 10-11 (previously “at least one...”); “the working direction” in claim 11; . **This is not meant to be an all-inclusive list of such occurrences. Applicant is required to review the claims and correct any other such occurrences of limitations lacking sufficient antecedent basis.**

In claim 7, line 2, it is unclear, via the use of the indefinite article “a”, whether “a housing” is intended to be the same housing previously set forth in claim 4. If so, Examiner suggests utilizing language such as “the housing” or “said housing” in claim 7 for clarity.

In claim 7, it is unclear as set forth in the claim to what “it” refers, for example, “it” could refer to the “suction head” or “the power tool”.

In claim 13, it is unclear as claimed whether “a suction unit”, “a vacuum”, and “a suction head” are intended to be the same suction unit, vacuum, and suction head previously set forth. It is also unclear what is meant by “at least as recited in Claim 3”, i.e., whether Applicant is intending to imply that other claims might possibly be incorporated, but if so, it is unclear which ones. It is also unclear as claimed whether the claimed “drilling and/or chipping tool” of claim

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13 is intended to be a subset of the “power tool” of claim 1. Examiner suggests rewriting claim 13 as follows for clarity:

13. Drilling and/or chipping tool with [a suction unit for producing a vacuum in a suction head of a] the suction device [at least] as recited in Claim 3, wherein the power tool is the drilling and/or chipping tool.

Claim Rejections - 35 USC § 102

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1-4, 6-10, 12-22, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0141836 to Ege et al.

Ege et al. discloses a suction device for a power drilling tool 2 with at least one “dust container 20” and at least one “suction head” 1 to be placed on a work piece 8 (at portion 3 of the “suction head” 1), wherein the dust container 20 is “integrated in”, i.e., forms a part of or is incorporated in, the “suction head” 1 (see Fig. 1).

Re claims 2-3, a suction unit including the “cooling fan” 17 and the motor M is “integrated in” the power tool for producing a vacuum in the suction head (see Fig. 1).

Re claims 4 and 6, note that the “suction head” 1 is supported on the housing of the power tool 2, and is detachably retained thereon via a snap-in connection 19, 19'. Re the claimed “unit” and “bearing unit” of claim 4, as broadly claimed, it is noted that a “unit” including a “bearing unit” including at least elements 13, 11, and 5 “support” the “suction head” 1 on the housing of the power tool 1 (insofar as the guide rods 46a and 48a forming the disclosed

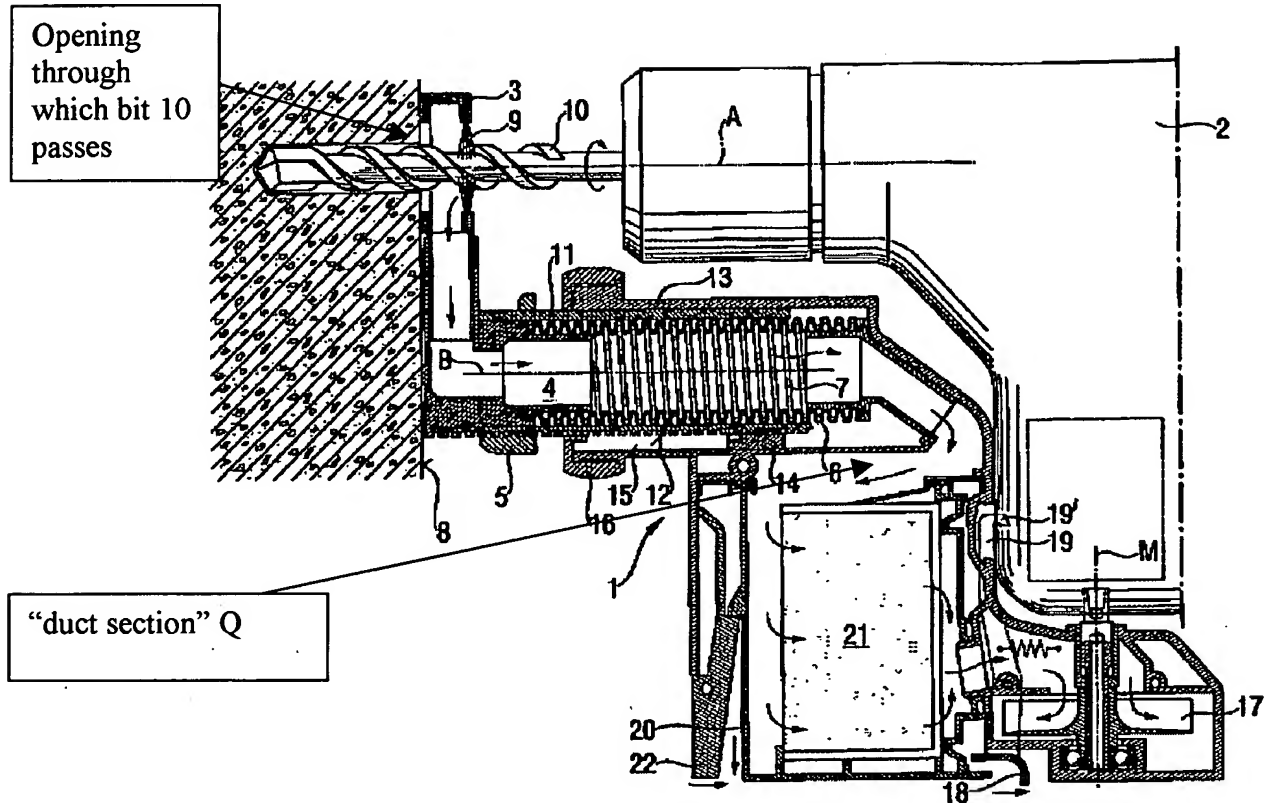
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bearing unit of the present invention serve to support the suction head on the power tool housing).

Re claim 7, it is noted that the “suction head” 1 is supported on the housing of the power tool 2 by the “bearing unit” including at least elements 13, 11, and 5 as described previously. It is further noted that the suction head 1 is indeed, as broadly claimed, “displaceable along a working direction” (such as the left right direction of the A axis of Figure 1) by, at the very least, moving the entire device (i.e., the power tool 2 in combination with the suction head 1) in the left-right direction as viewed in Figure 1, at the very least to move the device into a position adjacent the workpiece.

Re claim 8, note that the aforescribed “bearing unit” including at least elements 13, 11, and 5 includes the depth stop 5 (see Figure 1 and paragraph 0024).

Re claim 9, note that the suction head 1 includes at least one opening (labeled below in the reproduction of Figure 1) through which the tool bit 10 is guided during a drilling operation of the workpiece (workpiece is at the left side of the Figure and has a surface 8).



Re claim 10, it is noted that claim 10 broadly sets forth that “various dimensions can be selected for the opening”. It is noted that it is considered inherent that, at the very least, during the design process of the suction head, the designer “can” (as broadly claimed) select any one of an infinite number of various dimensions for the opening size.

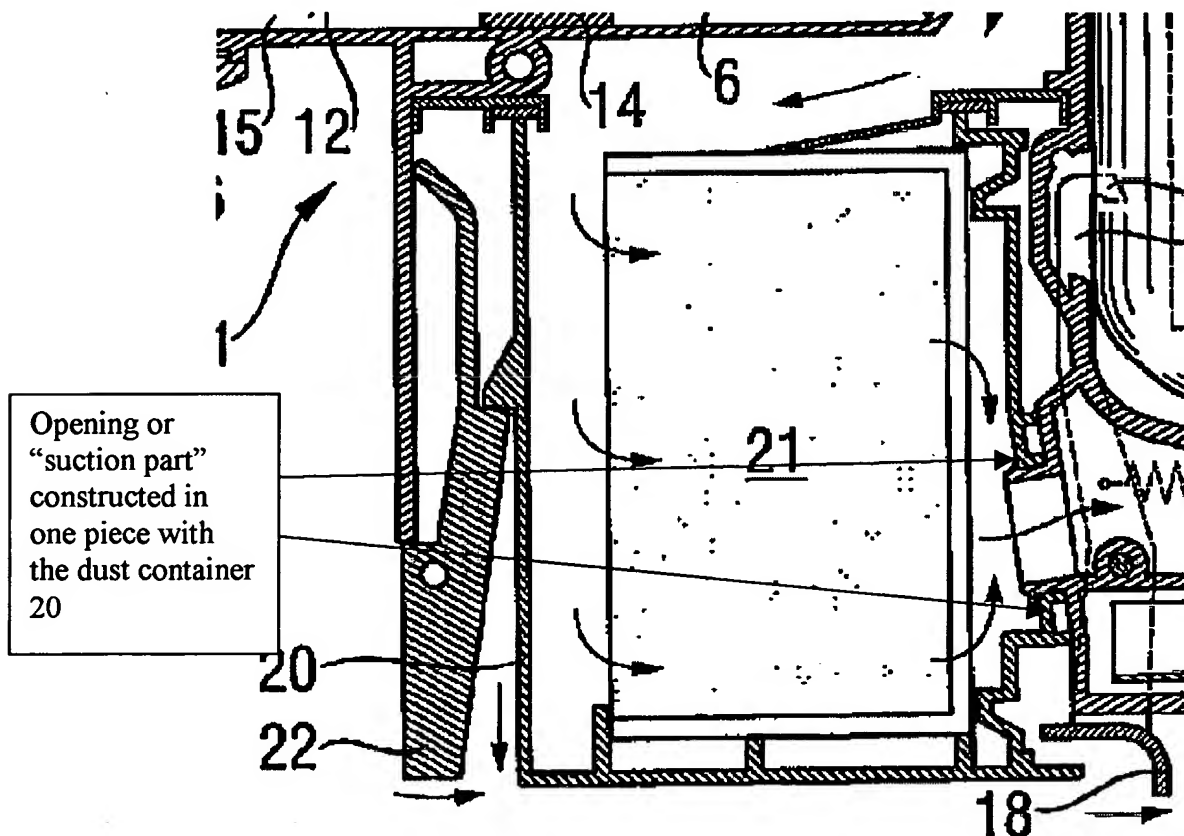
Re claim 12, an air stream (at least as defined by the arrows in Figure 1) is “capable” of being introduced into the dust container 20 through a “duct section” (including at least any one of the hollow portions 3 or the tube 4, or the above-labeled “duct section Q”, for example) in a circumferential direction of the dust container (see Figure 1).

Re claims 14-15, it is noted that the “suction part” 34a-34c of the present invention is not any sort of vacuum, but is merely a part through which suction occurs. That being said, it is noted that the above-labeled “duct section Q” is a part through which suction occurs, and which

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is thus considered to be a "suction part", and which "forms a single unit" (claim 14) that "forms an indivisible unit" (as best understood, see Figure 1 noting that at least the lower side of the duct section Q is of the same piece as the container 20 (see Figure 1). [Alternately, note that the opening through which air passes as it leaves (on the right side) of the dust container is a part through which suction occurs, which could thus alternatively be considered the claimed "suction part", and which is a single unit that is indivisible with the "dust container" 20].

Re claim 16, considering the alternate interpretation of the "suction part" set forth in the immediately preceding sentence, see the enlarged and labeled portion of Figure 1 below.



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Re claim 17, note that as broadly claimed, at least any of the latch piece of the snap-in device 19, 19' of the power tool 2, or the housing of the power tool 2, or simply the power tool 2 itself, can be considered the claimed "second unit" noting that the aforescribed unit of the "suction part" and "dust container" is at least ultimately "detachably retained" on any of these items.

Re claim 18, it is noted that considering the latch piece of the snap in device 19, 19' to be the claimed "second unit", the latches can be detached from the power tool by, at the very least, sawing or otherwise cutting them off, and are thus considered, as broadly claimed, to be "capable of being detachably retained on the power tool".

Regarding claim 19, note that filter 21 is ultimately supported "on" the "bearing unit" including at least elements 13, 11, and 5 (see Figure 1).

Regarding claim 20, it is noted that the housing of the power tool 2 can be considered the "second unit" as claimed as described previously, and thus, the single unit of the "suction part" and "dust container" is fixed by the snap-in connection 19, 19' at the side of the housing of the power tool 2 that faces the workpiece (having surface 8, see Figure 1).

Re claim 21, it is noted that air and removed material are suctioned up through left and right openings in element 3 (through which openings the tool bit 10 extends), and that such air and removed material are introduced "perpendicularly" to a working direction of the tool bit "directly" (insofar as the present invention accomplishes such "directly") into the container 20, noting the direction of the flow arrows at the point just prior to entry into the container 20 is apparently perpendicular to the direction A. Alternatively, it is noted that the claim does not set forth specifics of the working direction, i.e., working direction of what, and that the fan 17

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rotates around a vertical axis, and that as the flow passes through duct section Q labeled above, it is perpendicular to the vertical "working direction" of the fan 17.

Re claim 22, it is noted that the members 13 and 11 of the aforescribed "being unit" are considered to be "guide rods" as broadly claimed.

12. Claims 1, 4, 7-11, 13-14, 17-18, and 21, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,090,499 to Cuneo.

Cuneo teaches a suction device for a power drilling tool 38 including a "suction head" 10 (including at least elements 26, 24, 12, 34, etc., see Figure 1) to be placed on a workpiece at the surface of the "suction head" 10 labeled in Figure 1 as 40. Dust container 34 is "integrated in", i.e., forms a part of or is incorporated in, the "suction head" 10 (see Fig. 1).

Re claim 4, note that a "bearing unit" including at least collar element 16 serves to "support" the "suction head" 10 on the housing of the power tool 38 (see Figures 1, 2, and col. 2, lines 44-48). Also note that the bearing unit is "capable of being "detachably retained" on the power tool 38 by loosening and tightening the screw 17 so as to attach or detach the collar 16 from the tool 38 (see Figures 1-2 and col. 2, lines 44-48).

Re claim 7, firstly, note that the "suction head" 10 is supported on the housing of the power tool 38 by the "bearing unit" including at least collar 16 as described previously. It is further noted that the suction head 10 is indeed, as broadly claimed, "displaceable along a working direction" (such as the left right direction of Figure 1) by, at the very least, moving the entire device (i.e., the power tool 2 in combination with the suction head 1) in the left-right direction as viewed in Figure 1, at the very least to move the device into a position adjacent the workpiece.

Re claim 8, it is noted that elements 24 and 31 can also be considered to be part of the “bearing unit” as broadly claimed, and that element 31 is a depth stop (see Figure 1 and col. 3, lines 11-13, for example).

Re claim 9, note that the “suction head” 10 includes at least opening 44 on the left side of portion 26 and another opening on the right side of portion 26 through which the tool bit is guided during a drilling operation (see at least Figure 1).

Re claim 10, it is noted that “various dimensions” can be selected for the opening on the right side of portion 26 via the elastic membrane 43 (see Figures 1 and 6 and col. 2, line 64 through col. 3, line 2, for example).

Re claim 11, it is noted that the openings described previously of the portion 26 of the suction head 10 are shown in Figure 1 as forming ends of a funnel shaped receiving area that tapers in the horizontal working direction of the tool bit (see Figure 1 noting the tapered portions of the chamber 42).

Re claim 14, it is noted that the “suction part” 34a-34c of the present invention is not any sort of vacuum, but is merely a part through which suction occurs. That being said, it is noted that duct 19 is a part through which suction occurs, and which is thus considered to be a “suction part”, and which “forms a single unit” (claim 14) with the dust container 34 by virtue of it (19) being threaded to the dust container 34. In other words, when the two are threaded together, they form a fastened “single unit”.

Re claim 17, it is noted that, as broadly claimed, the cylindrical part 39 of the drill 38 can be considered to be the claimed “second unit”, noting that the “single unit” including the duct 19

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and dust container 34 are ultimately detachably retained on the "second unit" 39 via the screw 17/collar 16 arrangement described previously.

Re claim 18, it is noted that, as broadly claimed, the cylindrical "second" part 39 of the drill 38 is considered to be "capable of being detachably retained on the power tool" in that it is inherently able to be "detached" from the power tool by, at the very least, sawing or otherwise cutting it off.

Re claim 21, it is noted that air and removed material are suctioned up through left and right openings in element 26 (through which openings the tool bit extends), and that such air and removed material are introduced "perpendicularly" to a working direction of the screw 17 or a working rotation axis direction of the fan 13 "directly" (insofar as the present invention accomplishes such "directly") into the container 34 (see Figure 1, Figure 5).

Response to Arguments

13. Many of Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection set forth above, based on the different interpretation of the applied references. Examiner will address any arguments to the extent to which they still apply.

Many of Applicant's arguments with respect to the above-applied Ege and Cuneo references are directed to the point that the dust containers of these references are not integrated "in" (emphasis added on the "in") the elements that the previous action referred to as the "suction head" of the Ege and Cuneo references. However, it is noted that the above rejections have presented an alternate interpretation of the term "suction head" wherein the dust containers are indeed integrated into the larger whole suction head.

With respect to the Ege reference, it is noted that Applicant has asserted that the dust container is removable, and appears to use this fact to infer that thus, the dust container is not “integrated in” the suction head 3. While Examiner has above redefined what constitutes the “suction head” such that the dust container is “integrated” therein, Examiner would like to point out that even if the dust container is removable from the overall suction head now defined in the rejection, this does not preclude it from being considered to be “integrated in” the suction head. Merriam-Webster’s Online Dictionary defines “integrate” as “to form, coordinate, or blend into a functioning or unified whole”, “to unite with something else”, or “to incorporate into a larger unit”. Regardless of which of these definitions are used, it is noted that whether or not the dust container is removable from the overall suction head is irrelevant to the determination of whether it is “integrated” in or forming part of a unified whole (when the dust container is in the attached position), is united with the overall suction unit (in the attached position), or “incorporated” in the overall suction head.

It is further noted that Applicant may wish to additionally take at least BE 1009324 (already of record) into careful consideration when crafting any future amendments to the claims, noting that as shown in Figure 1 and described in the English abstract thereof, “suction head” 1 (having hole 23 through which drill bit 20 is guided in operation) having surface 3 to be placed against a workpiece (see Figures 2-3) has a dust container 7 incorporated therein, and wherein turbine wheel 5 is used to draw air (through filter 6) and debris perpendicularly to the working axis of the tool “directly” into the dust container 7. Furthermore, BE 1009324 teaches the use of guide rods 21, 22, and it is noted that the suction device is detachably connected (via collar 12 and wing nut 14) to the drill (see Figure 1), for example.

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Also, it is noted that U.S. Pat. No. 4,184,226 to Loevenich teaches a suction device for a drilling tool wherein the suction head (including at least elements 1 and 2 of Figures 1-3, for example) that is placed on work piece 6 has a dust container 1 integrated therein. It is noted that even though the dust is suctioned out of the dust container 1 of the suction head, that the chamber 1 is still considered to form a "dust container", noting that the abstract, in the last four lines thereof, explicitly teaches that debris formed by the drilling "collects" in the chamber means. Further note that an opening of the suction head (1+2) forms an end of a funnel shaped receiving area that tapers in the working direction of the drill bit 3 (see Figure 2, for example).

Conclusion

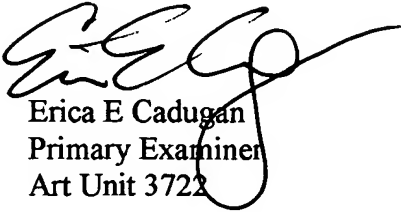
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadugan whose telephone number is (571) 272-4474. The examiner can normally be reached on M-F, 6:30 a.m. to 4:00 p.m., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Erica E Cadugan
Primary Examiner
Art Unit 3722

eec

January 18, 2007